



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

John A. Rushing

For: Diffuse Lighting Arrangement

Serial Number: 09/433,761

Filed: 11/04/99

Group Art Unit: 2875

Examiner: A. Ton

Reply Brief

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Brief  
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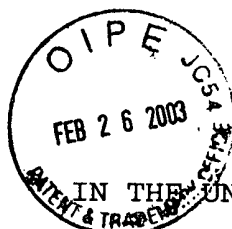
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It has been noted that the 35 USC 112 2nd paragraph rejection of claims 6-9 has been withdrawn.

With regard to Anticipation by Adler, of Appellants' claims 1-4 first, the Examiner has again failed to observe the teachings of Adler "as a whole".

Adler teaches lights on the power cord which are placed in a configuration to be received within the icicle type cover of Adler, which is the gist of his invention to produce light through the icicle shaped cover. To arbitrarily ignore the existence of the cover defeats the entire purpose of Adler.

Taking Adler as whole, he has a particular plurality of parts (power cord with lights thereon and icicle shaped covers) which could be labelled A, B and C, respectively.

Applicant has no need of C, as required by Adler, and therefore anticipation cannot exist.

Here see the decision in Lewmar Marine Inc., v. Barrient Inc., 3 USPQ2d 1766 (Fed. Cir. 1987):

"Under the current statute the test for anticipation is: "that which would literally infringe if later in time

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anticipates if earlier than the date of invention."

Clearly, since Appellant has no C, he could not infringe and therefore anticipation cannot exist.

With regard to the "series or parallel" choice offered by Adler, the Board is directed to the decision in Mendenhall v. Astec Industries, Inc., 13 USPQ2d 1913, 1939 (TN 1988), aff'd, 13 USPQ2d 1956 (Fed. Cir. 1989):

"When a claimed invention is not identically disclosed in a reference, and instead requires picking and choosing among a number of different options disclosed by the reference, then the reference does not anticipate."

The motivation to choose one configuration over the other is lacking since Adler states both are acceptable in his icicle. Here see the decision in In re Bezombes, Peyches, and Tissier, 164 USPQ 387 (CCPA 1970):

"Board's dismissal of claim limitation as "an obvious matter of choice" is not convincing in absence of some reason why a person skilled in the art would find it obvious."

Lehman et al teaches an indoor christmas tree string set having two lamps nearest the plug which are unshunted and connected to the plug by a wire of larger gauge than the rest of the wire, serving to create a fuse for the light string.

Appellant has no such fuse structure. His lights are for outside use and the fuse as taught by Lehman et al would not be

suitable for such use.

Appellant provides a CGFI which is actuated by a ground fault condition - something a fuse is incapable of accommodating because it is actuated by an excess current level. These can in no way be construed as equivalent in operation or structure.

Even combined with Adler the resultant structure would not be that which Appellant is claiming.

Here the Board is directed to the decision in Custom Accessories, Inc., v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ2d 1196 (Fed. Cir. 1986):

"Casting an invention as a combination of old elements leads improperly to an analysis of the claimed invention by the parts, not by the whole."

and in Panduit Corp., v. Dennison Manufacturing Co., 1 USPQ2d 1593 (Fed. Cir. 1987):

"A prior patent must be considered in its entirety (i.e, as a whole), including portions that would lead away from the invention in issue."

and in Vandenbert et al. v. Dairy Equipment Co., 224 USPQ 195 (CA FC 1984):

"In making its determination a court must view the prior art without reading into the patent's teachings."

and in Exparte Clapp, 227 USPQ 972 (BdPatApp&Int 1985):

"To support conclusion that claimed combination is directed to obvious subject matter, references must

either expressly or impliedly suggest claimed combination or examiner must present convincing line of reasoning as to why artisan would have found claimed invention to have been obvious in light of references' teachings."

Turning to the final paragraph, this is believed only to consist of opinions expressed by the Examiner which, as argued above and in the Brief, have no merit.

The Board has long held that obviousness rejections must be based on factual evidence. The Examiner has supplied none.

Here see the decision in In re Sponnoble, 160 USPQ 237 (CCPA 1969):

"Court must view prior art without reading into that art applicant's teachings; issue is whether teachings of prior art would, in and of themselves and without benefits of applicant's disclosure, make invention as a whole, obvious."

and in Ex parte Clapp, 227 USPQ 972 (B.P.A.I. 1985):

"Presuming arguendo that the references show the elements or concepts urged, the Examiner presented no line of reasoning as to why the artisan reviewing only the collective teachings of the references would have found it obvious to selectively pick and choose various elements and/or concepts from the several references relied on to arrive at the claimed invention. In the instant application, the Examiner has done little more than cite references to show that one or more elements or

some combinations thereof, when each is viewed in a vacuum, is known. The claimed invention, however, is clearly directed to a combination of element. That is to say, the appellant does not claim that he has invented one or more new elements but has presented claims to a new combination of elements. To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. The Board found nothing in the references that would expressly or impliedly teach or suggest the modifications urged by the Examiner. Additionally, the Board found no line of reasoning in the answer as to why the artisan would have found the modifications urged by the Examiner to have been obvious. Based upon the record, the artisan would not have found it obvious to selectively pick and choose elements or concepts from the various references so as to arrive at the claimed invention without using the claims as a guide."

Based on the above and afore presented arguments the Board is respectfully requested to overturn the rejections and pass the application on to allowance.

Respectfully submitted

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